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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,164	08/28/2001	Amit Patel	967.060US1	4647

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EXAMINER

JIANG, SHAOJIA A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 11/19/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,164

Applicant(s)

PATEL ET AL.

Examiner

Shaojia A Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office Action is a response to Applicant's amendment and response filed on September 8, 2003 in Paper No. 13 wherein claims 1-5 and 22-27 have been amended.

Currently, claims 1-12 and 22-28 are pending in this application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 8, 10-12, and 22-28 as amended now in Paper No. 13 are rejected under 35 U.S.C. 112, first paragraph, for containing new subject matter of record in the Office Action dated June 3, 2003. Applicant's amendment filed September 8, 2003 in Paper No. 13 with respect to this rejection of record in the previous Office Action June 3, 2003 have been fully considered but not found persuasive to remove the rejection.

As indicated in the previous Office Action June 3, 2003, Applicant's amendment adding the recitation "a first phase" is deemed to insert new matter into the claims since the specification as originally filed does not provide support for the recitation, "a first phase" comprising the specific ingredients herein. The original specification and claims do not teach "a first phase", but merely discloses that for example "The water phase is added to the oil phase to form an emulsion" (see page 3 line 16-17 of specification herein). Nowhere the specification teaches "a first phase". Consequently, there is nothing within the instant specification which would lead the artisan in the field to

believe that Applicant was in possession of the invention as it is now claimed. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111, CAFC 1991, see also *In re Winkhaus*, 188 USPQ 129, CCPA 1975.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5, 8, 10-12, and 22-28 as amended now in Paper No. 13 are rejected under 35 U.S.C. 112, second paragraph, for indefinite recitation of record in the Office Action dated June 3, 2003. Applicant's amendment filed September 8, 2003 in Paper No. 13 with respect to this rejection of record in the previous Office Action June 3, 2003 have been fully considered but not found persuasive to remove the rejection.

The recitation "a first phase" renders claims 1-5, 8, 10-12, and 22-28 indefinite. The recitation "a first phase" is not defined in the specification. Therefore, one of ordinary skill in the art could not interpret as to what would be considered to be "a first phase".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 and 22-28 as amended now in Paper No. 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esser (6,221,345, of record), Palinczar (4,724,139, of record), and Kasat et al. (5,424,070 , of record) in view of Bonastre Gilabert et al. (WO 2000001875, of record) and Kropf et al. (WO 2000047177, of record) for the same reasons of record stated in the Office Action dated June 3, 2003.

Applicant's remarks filed September 8, 2003 in Paper No. 13 with respect to the rejection of claims 1-12 and 22-28 made under 35 U.S.C. 103(a) in the previous Office Action June 3, 2003 have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

First, Applicant argues that there is no motivation to combine Gilabert et al. WO 2000001875 and Kropf et al. (WO 2000047177 with other references are unconvincing since Gilabert et al. has been cited by the examiner as a secondary reference for its teaching that the combination of the instant ingredients, glyceryl stearate, cetearth-20, cetyl palmitate, cetearl alcohol, dicapryl ether, caprate, cetearyl alcohol, and water is known in a cosmetic composition. Likewise, Kropf et al. has been cited by the examiner as a secondary reference for its teaching that the combination of the instant ingredients, glyceryl stearate, cetearth-12, cetyl palmitate, cetearl alcohol, dicapryl ether, caprate, cetearyl alcohol, and water is known in a cosmetic composition.

Again, Applicant argues that none of the references cited describes a formulation having the physical and chemical properties in claims 6, and 7-12. However, Esser clearly discloses that antiperspirant deodorant compositions comprise the instant

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ingredients, two or more of glycery stearate, dicapryl ether, cetearyl alcohol, Ceteareth-20, and water, and antiperspirant such as aluminum chlorohydrate, and further combining with glycerol (also known as glycerin as recited in claim 1, see Esser, col.2 lines 38-40). Thus, Esser's antiperspirant deodorant compositions read on the instant compositions regardless their physical and chemical properties since the physical and chemical properties of a formulation would not be considered to be a limitation to a formulation or a composition, as discussed in the previous Office Action.

Applicants argument that the Kasat reference is not aqueous, is not found convincing. However, the Esser patent teaches a creamy aqueous emulsion. Moreover, the instant claimed products are not directed to an aqueous solution. Further, the agents herein in the oil phase are known to be useful in antiperspirant deodorant compositions according the cited prior art herein.

Applicant further argues that the examiner pick and choose ingredients among a collection of disparate products. Nonetheless, as discussed in the previous Office Action, all cited primary references, Esser, Palinczar, and Kasat et al. disclose that antiperspirant deodorant compositions may comprise the instant ingredients.

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 SPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP 2145. More importantly, it has been held that it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for same purpose in order to form a third composition that is to be used for the

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very same purpose; idea of combining them flows logically from their having been individually taught in prior art. *In re Kerkhoven*, 205 USPQ 1069, CCPA 1980. See MPEP 2144.06.

Further, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). See MPEP 2145.

In the instant case, as discussed above and in the previous Office Action, motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is clearly obvious in view of the prior art.

The record contains no clear and convincing evidence of nonobviousness or unexpected results for the combination method herein over the prior art. In this regard, it is noted that the specification provides no side-by-side comparison with the closest prior art in support of nonobviousness for the instant claimed invention over the prior art.

In view of the rejections to the pending claims set forth above, no claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

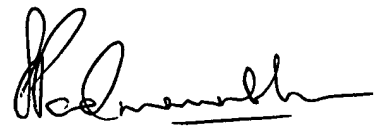
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

S. Anna Jiang, Ph.D.
Patent Examiner, AU 1617
November 6, 2003


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

11/17/03